

REMARKS

Claims 2, 3, 5, 7, 8, 10 and 12-22 are presently pending. Claim 1, 4, 6, 9 and 11 have been canceled. Claims 2, 3, 5, 7, 8, 10 and 12 have been amended. Claims 13-22 have been added. The specification has been amended.

Applicant respectfully requests reconsideration of the application in view of the foregoing amendments and the remarks appearing below.

Draftsperson's Objections to the Drawings

The draftsperson objected to the drawings filed on February 12, 2001 stating that the margins of FIGS. 1 and 3 are unacceptable. Applicants have revised the drawings accordingly. Corrected drawings are attached hereto, and have also been submitted to the draftsperson directly. In addition, Applicant has corrected two minor errors in the drawings, namely, changing element numeral "301" in FIG. 3 to "201" to correspond to the written description and changing the lead line corresponding to element numeral "310" for the same reason.

Objections to the Claims

The Examiner has objected to claims 1, 7 and 12 due to the following informalities. Claim 1 refers to an iteration step (c) wherein steps (b)(i) and (b)(ii) are repeated. However, claim 1 does not include steps (b)(i) and (b)(ii). Claim 7 is dependent upon itself. Claim 12 is dependent from a nonexistent claim.

Applicant has amended claims 1, 7 and 12 to overcome these informalities. Regarding claim 1, Applicant has amended this claim to recite that the iteration step refers to steps (a) and (b), which are present in claim 1. Regarding claim 7, Applicant has amended this claim to depend from new claim 16. Regarding claim 12, Applicant has amended this claim to depend from new claim 19.

Consequently, Applicant respectfully requests that the Examiner withdraw the objections.

Rejection under 35 U.S.C. § 101

The Examiner has rejected claims 1-12 under 35 U.S.C. § 101 as being directed to nonstatutory subject matter. In particular, the Examiner asserts that claims 1-12 are directed to

an abstract idea not limited to a practical application in the technological arts. Applicant respectfully disagrees.

Claims 2, 3, 5, 7, 8, 10 and 12-21, as amended and added, are directed to a method of producing an invention document by performing at least the steps recited in the various claims. The result of performing the method of these claims, i.e., an invention document containing information relating to a basic invention, is a “useful, concrete and tangible result.” AT&T Corp. v. Excel Communications, Inc., 172 F.3d 1352, 1368, 1358-59 (Fed. Cir. 1998). State Street Bank & Trust Co. v. Signature Financial Group, Inc., 149 F.3d 1368, 1373 (Fed. Cir. 1998) (“Today, we hold that the transformation of data . . . constitutes a practical application of a mathematical algorithm, formula, or calculation, because it produces ‘a useful, concrete and tangible result’—a final share price momentarily fixed for recording and reporting purposes and even accepted and relied upon by regulatory authorities and in subsequent trades.”). Consequently, the claims at issue meet the requirement for statutory subject matter that the Federal Circuit laid out in State Street and further reinforced in AT&T.

Some, including the U.S. Patent and Trademark Office (USPTO), have asserted that despite the holdings of the Federal Circuit in State Street and AT&T, there is still life to the requirement of pre-State Street/AT&T law that statutory subject matter be in the “technological arts,” meaning that the subject matter must fall within the context of scientific technology. For example, relative to a process that could be performed by a human or a computer, the process must be claimed in the context of a computer in order to meet the “in the technological arts” requirement for statutory subject matter. While Applicant does not doubt that statutory subject matter must be within the “technological,” i.e., “useful,” arts, Applicant disputes that the definition of “technological arts” requires a process to be performed by a computer to be statutory, even though when performed by a human the process produces a useful, concrete and tangible result in the manner of State Street and AT&T.

To the best of Applicant’s knowledge, the only post-State Street/AT&T decision cited in support of this definition of the term “technological art” is Ex parte Bowman, 61 USPQ2d (BNA) 1669 (Bd. Pat. App. & Int. 2001). Generally, in Ex parte Bowman the Board of Patent Appeals and Interferences (BPAI) held that a claim that could be performed by either a human or

a computer, but did not recite any limitations directed to computer implementation, is not subject matter falling within the "technological arts" and thus is not statutory. *Id.*, at 1671. This holding appears to be at odds with the law of State Street and AT&T. For example, in AT&T the Federal Circuit found that a claim to process that did not include any limitations directed to a computer were indeed statutory. AT&T, at 1361.

Applicant submits that there are at least two serious problems with relying on Ex parte Bowman to support a position that appears to be in opposition to the Federal Circuit's holdings in State Street and AT&T. First, Ex parte Bowman applied pre-State Street/AT&T law long after the Federal Circuit decided State Street and AT&T without discussing, let alone mentioning whatsoever, the State Street and AT&T decisions. Since there appears to be a large amount of tension between pre- State Street/AT&T law on the meaning of "useful" or "technological" art and the State Street and AT&T decisions, the BPAI should have addressed these two cases in its decision. Second, the BPAI indicated that its Ex parte Bowman decision was not written for publication. Therefore, the Ex parte Bowman decision is not binding precedent on which the USPTO should rely. Rather, the USPTO should rely on Federal Circuit law such as State Street and AT&T.

As discussed above, an analysis of the claims at issue under present Federal Circuit law, e.g., State Street and AT&T, shows that these claims indeed fall within 35 U.S.C. § 101. Consequently, Applicant respectfully asserts that claims 2, 3, 5, 7, 8, 10 and 12-22, as added and amended, are directed to statutory subject matter and, therefore, requests that the Examiner withdraw the present rejection.

Rejection under 35 U.S.C. § 112, First Paragraph

The Examiner has rejected claims 1-12 under 35 U.S.C. § 112, first paragraph, as failing to enable someone having ordinary skill in the art to use the invention. In particular, the Examiner states that because the application fails as a matter of fact to satisfy 35 U.S.C. § 101, then the application also fails as a matter of law under 35 U.S.C. § 112, first paragraph, to enable someone skilled in the art to use the invention. Applicant respectfully disagrees.

For the reasons discussed above relative to the rejection under 35 U.S.C. § 101, Applicant believes that the claims as a matter of fact are directed to statutory subject matter and, therefore,

satisfy 35 U.S.C. § 101. Consequently, Applicant asserts that the application does not fail as a matter of law under 35 U.S.C. § 112, first paragraph, to enable someone skilled in the art to use the invention. Therefore, Applicant respectfully requests that the Examiner withdraw the present rejection. If the Examiner again rejects any of the claims under 35 U.S.C. § 112, first paragraph, Applicant reserves the right to further argue the rejection.

Rejection under 35 U.S.C. § 102

The Examiner has rejected claims 6-10 under 35 U.S.C. § 102(b) as being anticipated by PATENT IT YOURSELF (6th ed., 1997) (Nolo Press Berkeley) by David Pressman, stating that Pressman discloses all of the limitations of these claims. Applicant respectfully disagrees.

The book, PATENT IT YOURSELF, is generally a how-to guide for inventors having little or no experience with the processes of inventing, seeking legal protection for an invention and marketing an invention. In this book, Pressman provides information in a variety of formats, including instructions, examples, lists and descriptions, among others, for increasing the knowledge of inventors regarding the processes noted above. In Chapter 2, Section B, "Inventing by Problem Recognition and Solution," Pressman discloses that inventing is generally a two-step process: "1) recognizing a problem, and 2) fashioning a solution" to the problem. Pressman goes on to present a number of specific inventions and addresses for each one the problem recognized and the solution to the problem.

In contrast, the present invention is directed to, among other things, a method of producing an invention document, e.g., an invention disclosure or a patent application, among others, utilizing a structured system of asking an inventor, or inventors, one or more types of questions particularly formulated to elicit one or more corresponding types of responses from the inventor(s). After the inventor(s) respond, at least some of the subject matter of the response(s) is included in the invention document. This structured system has a number of benefits, including the creation of an invention document that enables an invention and describes enhancements of a basic invention.

Regarding new independent claim 16, which generally replaces original claim 6, claim 16, requires, among other things, the steps of: 1) selecting a first questioning theme selected to elicit from at least one inventor at least one enhancement of at least one of a plurality

of aspects of a basic invention; 2) eliciting from the at least one inventor at least one of the aspects of the basic invention that relates to said first questioning theme and 3) eliciting from the inventor via the first questioning theme the at least one enhancement. Pressman does not disclose these steps. Pressman, at most, can be said to disclose that an inventor asks the questions, "what is the problem?" and "what is a solution to the problem?" However, neither of these questions can be fairly said to be directed to at least one aspect of a plurality of identified aspects that has been elicited from at least one inventor, as required by claim 16. Nor can it be fairly said that either of these questions particularly addresses an enhancement relating to the particular identified aspect.

In addition, new claim 16 also requires the step of communicating to the at least one inventor the concept of a ladder of abstraction. Neither Pressman nor any other reference of record discloses or suggests this step.

In view of the foregoing, Applicant asserts that Pressman fails to disclose or fairly suggest a number of limitations of new claim 16. Consequently, PATENT IT YOURSELF cannot anticipate new claim 16, nor claims 7-10, 17 and 18 that depend therefrom. Therefore, Applicant respectfully requests that the Examiner withdraw the present anticipation rejection.

Rejections under 35 U.S.C. § 103

The Examiner has rejected claims 1-5, 11 and 12 under 35 U.S.C. § 103 as being obvious in view of the Pressman book, discussed above, and FROM PATENT TO PROFIT: SECRETS & STRATEGIES FOR THE SUCCESSFUL INVENTOR, Avery (1998) by Bob DeMatteis, stating Pressman discloses a method containing all of the limitations of these claims except facilitating conception of inventive elements using creative stimulus comprising how-type questions. The Examiner then asserts that DeMatteis discloses this limitation and further asserts that it would have been obvious to a person having ordinary skill in the art at the time of the invention to utilize the teachings of DeMatteis in the Pressman method. Applicant respectfully disagrees.

The Pressman disclosure is as discussed above relative to the anticipation rejection.

DeMatteis, like Pressman, generally discloses how-to guidance for inventors having little or no experience with the processes of inventing, seeking legal protection for an invention and marketing an invention.

Regarding new independent claim 13, which generally replaces original claim 1, claim 13 requires, among other things, the step of questioning at least one inventor with how-type questions structured to elicit at least one response from the at least one inventor directed to enabling at least one detail of a basic invention. Neither DeMatteis nor Pressman disclose or suggest this step.

The Examiner asserts that certain phrases appearing in the table of contents of DeMatteis' book are questions corresponding to the specific how-type questions of new claim 13. Applicant believes the Examiner's assertion is improper. DeMatteis' table of contents includes the phrases "How to Get Prototypes Made at Little or No Cost to You" and "How to Make Your Invention 'People Friendly.'" First, these phrases are not questions. They are titles of sections that provide guidance to a reader on the subjects of getting a prototype made and making an invention "people friendly." Second, even if these phrases were questions, which they are not, neither of them can be fairly said to be directed to eliciting at least one response from an inventor directed to enabling at least one detail of a basic invention.

In addition, new claim 13 also requires the step of communicating to the at least one inventor the concept of a ladder of abstraction. Neither Pressman, DeMattaas nor any other reference of record discloses or suggests this step.

Furthermore, Applicant asserts that the Examiner has made the present rejection in hindsight of the claims. Use of hindsight in this manner is not proper.

For at least these reasons, Applicant respectfully submits that the obviousness rejection of new claim 13, and claims 2, 3, 5, 14 and 15 that depend therefrom, is improper.

Regarding new claim 19, which generally replaces original claim 11, claim 19 requires, among other things, steps included in new claim 13, discussed immediately above, as well as steps included in new claim 16, discussed above in connection with the anticipation rejection. Since new claims 13 and 16 are allowable over the cited references for the reasons discussed

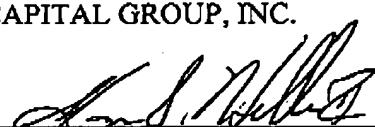
above, new claim 19 is allowable for at least the reason that it includes the subject matter of allowable claims 13 and 16.

In view of the foregoing, Applicant respectfully requests that the Examiner withdraw all of the rejections made under 35 U.S.C. § 103.

Conclusion

In view of the foregoing, Applicants respectfully submit that claims 2, 3, 5, 7, 8, 10 and 12-22, as amended, are in condition for allowance. Therefore, prompt issuance of a Notice of Allowance is respectfully solicited. If any issues remain, the Examiner is encouraged to call the undersigned attorney at the number listed below.

Respectfully submitted,
IPCAPITAL GROUP, INC.

By: 
Morgan S. Heller II
Registration No.: 44,756
Down Rachlin Martin PLLC
Tel: (802) 863-2375

Attorneys for Applicant

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